

III. REMARKS

Status of the Claims

Claims 1, 7 and 12 are amended. Claims 1-12 are presented for further consideration.

Summary of the Office Action

Claims 1-12 stand rejected under 35USC102(e) on the basis of the cited reference Sladek, U.S. Patent No. 6,622,016. The Examiner is respectfully requested to reconsider his rejection in view of the above amendments and the following remarks.

The Invention

In the mobile terminal of this invention information relating to the capability of the mobile terminal is stored in the mobile terminal memory and transmitted as part of the payload of a message without network inquiry. In this manner any necessary capability check is accomplished at the initiation of a service.

Discussion of the Cited Reference

The Examiner has cited the reference Sladek in support of the rejection based on anticipation. The reference Sladek describes a system by which a subscriber profile can be modified to include additional services. It primarily involves communications at the network level and describes little, if any, contribution by the mobile terminal besides transmitting identification information. There is no discussion of a capability negotiation. Sladek describes its system, at column 7, lines 4-14, as follows:

"In accordance with another principal aspect of the invention, a service overlay or other service modification that is provided for a subscriber can be temporary. For instance, a subscriber profile can be modified to add or activate a designated service that is normally not available or active for the subscriber. In turn, in

response to a designated stimulus, such as the expiration of a specified time period, or the subscriber providing a predefined feature code, for instance, the profile can be modified again so as to put it back into its original state. Alternatively, other logic can be employed to stop providing the overlay service when desired."

The basic process of the system of Sladek is described in column 6, line 51 to column 7, line 3, as follows:

"For instance, if the subscriber profile for a given mobile station includes an origination trigger that causes the serving system to query an HLR in response to any digit sequence dialed by the subscriber, the subscriber profile might be changed so as to instead include an all-digits trigger pointing to an SCP. The SCP may then apply a special set of service logic for the subscriber, including a service feature that the HLR would not normally have provided for the subscriber. As another example, if, on call termination to the mobile station, an HLR would normally send an advanced termination trigger to the serving system that would cause the serving system to query a designated SCP for call processing instructions, the subscriber profile as maintained by the HLR might be modified to instead provide the serving system with an advanced termination trigger that will cause the serving system to query a different central control point for call processing instructions. That different central control point may then execute a set of service logic to carry out a function that would normally not have been performed by the designated SCP."

There is no discussion with respect to a capabilities negotiation between the mobile terminal and a network component. It is clear that the only message from the mobile terminal anticipated by the system is that the mobile station may trigger an inquiry among certain network components. There is no indication that capability information is transmitted with the "origination trigger" of the reference Sladek. The reference Sladek therefore fails to support the Examiner's rejection.

The Issue of Anticipation

It is well settled that a claim is anticipated, "only if each and

every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (See CHISOLM, Federal Circuit Guide, Pg. 1221).

The elements of the claim and their function and purpose within the claim must be reviewed in a manner similar to an infringement analysis. If the device described in the cited reference would not infringe if it was later, it will not anticipate if the reference is earlier.

Applying this standard to the system of the reference Sladek, it becomes clear that the system is missing significant elements of independent claims 1, 7 and 12. There is no provision in Sladek for transmitting capability information in the payload of a message upon initialization. Claim 1 states:

"means for preparing a message for transmission comprising processing according to a specific protocol stack, means for transmitting the message comprising a header part and a payload part, wherein the mobile terminal device further comprises means for packing the capability information into the payload part of the message before the message is transferred to the protocol stack and wherein said message is transmitted without separate request."

Equivalent language also is contained in claims 7 and 12. Since these elements form no part of the system of system of Sladek, there would be no infringement, if Sladek was later, therefore, the cited reference does not support the rejection by the Examiner based on anticipation.

The above arguments are equally applicable to the rejected dependent claims 2-6 and 8-11.



For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

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Respectfully submitted,

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